

## **REMARKS**

At the outset, Applicants wish to thank Examiner Faber for the courtesies extended during the telephone interview on April 2, 2008. The Office Action dated December 26, 2007 has been received and its contents carefully noted. Claims 46-96 remain pending in the application. In order to better define that which Applicants regard as the invention, claims 46-56, 63-73, and 80-90 have been amended. No new matter has been added. Support for the amendments is provided in the original claims, Figures 1-7, and related text of the specification. In view of these actions and the following remarks, reconsideration of this application is now respectfully requested.

### **Claim Objections**

The Examiner objects to claims 50, 67, and 84 due to apparent typographical errors. In view of the amendments to claims 50, 67, and 84, Applicants respectfully submit that the objection has been rendered moot. In particular, the claims no longer recite that “the at least one subcreative pool includes multiple subcreative pools.” Withdrawal of the objection is therefore in order and is respectfully requested.

### **Claim Rejections under 35 U.S.C. § 101**

Claims 63-96 are rejected under 35 U.S.C. § 101 because the Examiner asserts that the claimed invention is directed to non-statutory subject matter. According to the Examiner, the “claims disclose computer program per se that is not embodied on a computer readable medium.” (Office Action, p. 4, lines 27-28.) Applicants respectfully traverse the rejection, because contrary to the Examiner’s assertion, the claims do not claim computer programs per se but recite sufficient structure to carry out aspects of the present invention.

In particular, claims 63-79 are directed to a system comprising elements written in means plus function format according to 35 U.S.C. § 112, paragraph 6. As MPEP § 2106 II.C. explains, “[w]here means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and ‘equivalents thereof’ that correspond to the recited function.” Therefore, the

structures corresponding to the elements written in means plus function format can be found in the present specification. For example, referring to FIG. 1, the present specification explains:

Server-side system 22 includes an advertising system processor 26 connected to an advertising system processor 26 connected to an advertising database 28, and a user interface 30. . . . Advertising system processor 26 comprises any conventional computer, for example a personal computer, server or mainframe, capable of performing the functions described below. Similarly, advertising database 28 comprises any conventional storage system for storing the data described below as well as software for performing the processes of the present invention.

(Present specification as filed, p. 9, lines 16-25, emphases added.) Accordingly, the structure in the present specification for the means recited in claims 63-79 includes “any conventional computer” connected to “any conventional storage system . . . storing . . . software” which is accessed and performed by the conventional computer. According to MPEP § 2105, “a claimed computer-readable medium encoded with a computer program” is statutory. The “conventional storage system” described in the present specification clearly corresponds with the “claimed computer-readable medium” required by MPEP § 2105. The structure in the specification is incorporated into the means plus function language of claims 63-79 according to 35 U.S.C. § 112, paragraph 6.

Meanwhile, claims 80-96 expressly claim a “program product comprising a storage device containing instructions operable on a computer for the automated generation and serving of aggregate creatives, the instructions operable with the computer to perform the steps of . . .” Thus, the claims include “a storage device” that corresponds with the “claimed computer-readable medium” required by MPEP § 2105.

In view of the structure, e.g., a storage device for computer readable instructions, clearly claimed in claims 63-96, Applicants respectfully submit that claims 63-96 comply with the requirements in MPEP § 2105 and are statutory.

**Claim Rejections under 35 U.S.C. § 102**

Claims 46, 50, 51, 53, 54, 59-62, 63, 67, 68, 70, 71, 76-79, 80, 84, 85, 87, 88, and 93-96 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. App. No. 2002/0036654 to Evans et al. (“Evans”). Applicants respectfully traverse the rejection, because Evans fails to teach each and every claim in independent claims 46, 63, and 80. In particular, claims 46 and 80 have been amended to recite “assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms, comprising the steps of: rotating through the at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative.” Similarly, claim 63 has been amended to recite “means for assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms, the means for assembling comprising: means for rotating through the at least one set of more than one subcreative; and means for selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative.”

According to the present specification, an aggregate creative is “one type of electronic advertisement in which multiple advertisements appear together in one or more groups.” (See specification as filed, p. 8, lines 9-10.) Meanwhile, a subcreative is “an individual advertising message that is a member of an aggregate creative.” (See specification as filed, p. 8, lines 13-14.) Furthermore, “[a]n aggregate creative form,’ or ‘form,’ is a single snapshot of an aggregate creative which has a particular set and order of displayed subcreatives.” (See specification as filed, p. 8, lines 20-21.) To illustrate these concepts in an example, an aggregate creative may be an online advertisement that appears on a webpage with a different combination of sub-advertisements (subcreatives) each time the webpage is accessed, and an aggregate creative form refers to a specific appearance of the advertisement with a specific

combination of sub-advertisements (subset of subcreatives) when the webpage is accessed on a single occasion.

The present specification explains that “the present invention provides for the creation of multiple aggregate creative forms with different sets and/or orders of subcreatives.” (See specification as filed, page 8, lines 21-23.) Specifically, with reference to FIG. 5, the present specification states:

The aggregate creative definition is operated, for each aggregate creative form that is to be generated, each time selecting one or more stored subcreatives from one or more pools of subcreatives in accordance with the definition (step 94), assembling the subcreatives and container into the aggregate creative form (step 96) and storing the aggregate creative form (step 98).

In accordance with the aggregate creative definition, the process of assembling aggregate creative forms (steps 94, 96, and 98) is repeated until the process ends (stop 99), at which time the process of assembling the aggregate creative ends (step 88).

(See specification as filed, p. 12, line 24-p. 13, line 1.)

Correspondingly, aggregate creative forms can be assembled by selecting subsets of more than one subcreative to be included in the aggregate creative forms, as generally recited by claims 46, 63, and 80. Moreover, the present specification explains that rotation algorithms may be employed as a technique for traversing a set of subcreatives and selecting the subsets of subcreatives to be assembled into the aggregate creative forms. (See present specification as filed, p. 15, line 24-p. 16, line 20.) Thus, claims 46, 63, and 80 also recite that assembling aggregate creative forms includes “rotating through the at least one set of subcreatives.”

Contrary to the claimed invention, Evans fails to teach or suggest assembling a plurality of aggregate creative forms based on a selection of subsets of more than one subcreative during rotation through at least one set of subcreatives, where the subsets include different combinations of more than one subcreative. Rather, the system of Evans is directed toward a user-driven process for creating a single layout of product references in a single advertisement (See, e.g., Evans, paragraphs [0048] and [0051]-[0052].) For example, with reference to FIG. 3, Evans states:

In step 302, advertising formats are displayed for the user. In step 304, the user selects an advertising format to sue. In step 306, at least one template corresponding to the selected advertising format may be displayed. In step 308, at least one product reference is displayed for the user. In step 310, the user selects at least one product reference. In step 312, the selected product reference may be displayed on the template. In step 314, a preview of the advertisement may be created for the user. In step 316, the user may review the preview, and, if satisfactory, may authorize the production of the advertisement. In step 318, the advertisement may be produced, in an electronic format, in a printed format, etc.

(Evans, paragraph [0048].) Steps 302 through 316 produce just one advertisement for subsequent production in step 318. Nowhere does Evans disclose that a plurality of advertisements are assembled as recited by the claims. Furthermore, steps 304, 310, and 316 require action and/or input from the user. A process which requires such manual interaction by the user is clearly more suitable for the generation of a single advertisement, rather than a plurality of advertisements. As such, the manual process of Evans teaches away from generating and storing a plurality of aggregate creative forms.

Citing paragraphs [0088] and [0095] of Evans, the Examiner asserts: “Each product being advertised has multiple product references from which the assistance layout program may choose. Since the program has multiple product references to choose from, it provides greater flexibility creating multiple advertisements.” (Office Action, p. 6, lines 10-13.) Applicants respectfully submit that, contrary to the Examiner’s assertion, Evans discloses nothing about creating a plurality of advertisements. Paragraphs [0088] and [0095] of Evans merely describe creating a single advertisement, where product references of different sizes are available for each product to facilitate the layout of product references in the single advertisement. (*See* Evans, paragraphs [0088] and [0095].) Indeed, multiple product references are employed in order to enable the creation of an optimal, i.e. single, advertisement according to a predefined set of priorities. (*See* Evans, paragraphs [0088] and [0095].)

The Examiner also asserts: “. . . it is inherently known if the Evans et al.’s method is capable of performing the functionality once, then it may generate the same functionality over again. Thus multiple computer-created advertisements have the functionality to be generated.” (Office Action, p. 5, lines 15-19.) As the goal of Evans is to enable the creation of an optimal advertisement, the repeated execution of Evans would merely produce the same advertisement over and over again, contrary to the present claims which require that the plurality of aggregate creative forms include “different combinations of more than one subcreative.” However, assuming that repeating the method of Evans could generate a plurality of different advertisements, the plurality of advertisements would not be assembled by rotating through the product references and selecting subsets of product references to be included in the plurality of advertisements, as required by the claims. Instead, each subset would be created one at a time during each execution of the method of Evans. Indeed, the present specification contrasts the claimed invention from the inefficient process suggested by the Examiner. For example, the present specification explains “that one advantage of the present invention over prior art, manual methods for assembling creatives, is the ability to automatically generate large numbers of aggregate forms from predetermined sets of data.” (See present specification as filed, p. 14, line 31-p. 15, line 5.)

Furthermore, the Examiner explains that Evans “fails to specifically disclose that wherein each subset of subcreatives has a different combination of subcreatives, and the aggregate creative appears to rotate subcreatives when the step of selecting one of the aggregate creative forms and the step of retrieving the selected aggregate creative form for the transmission are repeated.” (Office Action, p. 13, lines 5-9.) Thus, the Examiner concedes that Evans fails to disclose a “plurality of subsets including different combinations of more than one subcreative” as recited in claims 46, 63, and 80. In addition, the Examiner concedes that Evans fails to teach or suggest the idea of rotating subcreatives.

According to the Examiner, U.S. Pat. App. No. 2002/0188635 to Larson (“Larson”) “discloses the use of a preview (reduced-size; Paragraph 0061) image

display advertisements depicted in various locations in an automatically rotating fashion” and “discloses that the ads may periodically exchange places after a specified amount of time such as hourly or daily. (Paragraph 0138-0139).” (*See Office Action, page 10, lines 13-17.*) At most, Larson teaches rotating individual advertisements at the time a web page is served. (See Larson, paragraphs [0137]-[0138].) In contrast to Larson, however, claims 46, 63, and 80 do not recite the direct rotation of individual advertisements during transmission on an electronic network, such as a web page. Rather, claims 46, 63, and 80 recite “rotating through the at least one set of subcreatives” as a part of assembling the aggregate creative forms before the aggregate creative forms are even stored for subsequent selection and retrieval for transmission. Moreover, the Examiner’s application of Larson depends on the fact that a subset of subcreatives may include a single subcreative. (*See Office Action, p. 13, lines 9-10.*) However, the claims clearly recite that the subset of subcreatives include “more than one subcreative.” Therefore, Larson fails to cure the deficiencies of Evans. Indeed, Applicants respectfully submit that the Office Action fails to indicate how any of the other applied references cure the deficiencies of Evans.

Accordingly, Evans fails to teach or suggest each and every element of independent claims 46, 63, and 80, because it fails to disclose assembling a plurality of aggregate creative forms based on a selection of subsets of more than one subcreative during rotation through at least one set of subcreatives, where the subsets include different combinations of more than one subcreative. As a result, withdrawal of the rejection of claims 46, 63, and 80 is in order and is respectfully requested. In addition, Applicant respectfully submits that dependent claims 50, 51, 53, 54, 59-62, 67, 68, 70, 71, 76-79, 84, 85, 87, 88, and 93-96 are allowable at least for the reason of their dependency on allowable base claims 46, 63, and 80.

### **Claim Rejections under 35 U.S.C. § 103**

Claims 47-48, 64-65, and 81-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in further view of U.S. Pat. App. No. 2002/0147645 to Alao et al. Claims 49, 52, 58, 66, 69, 75, 83, 86, and 92 are rejected under 35 U.S.C. §

103(a) as being unpatentable over Evans, in further view of Larson. Claims 55, 72, and 89 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans. Claims 57, 74, and 91 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans, in further view of U.S. Pat. App. No. 2003/0191693 to Aphek. Applicant respectfully submits that dependent claims 47-49, 52, 55, 57, 58, 64-66, 69, 72, 74, 75, 81-83, 86, 89 and 91, and 92 are allowable at least for the reason of their dependency on allowable base claims 46, 63, and 80.

In light of the amendments to the claims and the remarks provided hereinabove, Applicants respectfully submit that the present application is now in condition for allowance. However, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicants' representative, then the Examiner is invited to contact the undersigned by telephone in order that further prosecution of this application can thereby be expedited.

Respectfully submitted,

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